Doc Code: AP.PRE.REQ

PTO/SB/33 (09-08)
Approved for use through 10/31/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): U 016025-8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on June 29, 2009

Signature: _____

Typed or printed name: CLIFFORD J. MASS

Application Number	Filed
10/556,936	July 19, 2006

First Named Inventor: Kristian Knak NYGAARD, ET AL

Art Unit	Examiner
2425	R.S. Stronczer

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 30086.
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

CLIFFORD J. MASS
Typed or printed name

(212) 708-1890
Telephone number

29 June 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kristian Knak **NYGAARD**, et al.

Serial No. 10/556,936 Group No:. 2425

Filed: July 19, 2006 Examiner: R.S. Stronczer

Confirmation No.: 5575

For: SYSTEM FOR TRANSMITTING INFORMATION FROM A STREAMED PROGRAM TO EXTERNAL DEVICES AND MEDIA

Attorney Docket No.: **U 016025-8**

Commissioner for Patents
P.O. Box 1430
Alexandria, VA. 22313

Sir:

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Summary

In the final action of 01 April 2009, the Examiner rejected claims 75-78, 82-86, 95, 98-100, 103-106, 116, 127-130, 150, and 156 under 35 USC 103(a) as allegedly being unpatentable over Logan et al., (US2005/0005308) in view of Reisman (US2003/0229900). Applicants respectfully note that the final action also rejects claim 115 under 35 USC 112, second paragraph. However, this claim was previously cancelled (see Amendment filed 16 January 2009).

It is respectfully submitted that there are one or more essential elements in the above claims needed for a prima facie rejection which are not present in the above cited references.

For example, it was pointed out in the Final Official Action response, among other limitations, that all the independent claims of the present application include the following limitation:

"identifying the selection based on a time at which the selection was selected with respect to rendering progress of the streamed broadcast program on the display"

It is respectfully submitted that neither Logan nor Reisman, either separately, or in combination, describe **explicitly or even implicitly**: "identifying

the selection based on a time at which the selection was selected with respect to rendering progress of the streamed broadcast program on the display".

It is further respectfully submitted that the arguments made in the Final Official Action are factually deficient with respect to how the limitations are described in the cited art.

More detailed discussion

The discussion below shows how the arguments used in the rejection are factually deficient.

In overview, claim 150 is directed towards a Headend system for transmitting, to a target device, a video and/or audio sequence based on a selection of a streamed broadcast program made by a user.

The system of claim 150 is now described in more detail.

A streamed broadcast program is broadcast to a user for being rendered on a display.

While viewing the streamed broadcast program, the user selects a selection from the streamed broadcast program using a user selection unit.

An identifier unit is operative to identify the "selection" selected by the user based on a time at which the selection was selected with respect to rendering progress of the streamed broadcast program on the display.

In other words, the user selects a selection at a particular time. The identifier unit then identifies the selection which was selected by the user based on the time the selection was selected.

Therefore, the identification of the selection based on the time the user selected the selection is performed **after** the user selected the selection. This point is important to note so that claim 150 is not confused with other references, for example, paragraph 42 of Logan, et al.

The transmitting unit is operative to transmit a video and/or audio sequence based on the selection of the streamed broadcast program to at least one of an external device and an external medium.

None of the references cited describes identifying a selection at a Headend based on a time at which the selection was selected with respect to the rendering progress of the streamed broadcast program and transmitting a video and/or audio sequence based on the selection of the streamed broadcast program to an external device and/or medium.

The Final Official Action states that Logan inherently requires identifying the location of said play in the broadcast stream relative to the whole stream.

The Final Official Action is therefore agreeing that Logan does not describe the limitation of claim 150. The Official Action is claiming that the limitation is inherent.

It will now be shown why the limitation of claim 150 is not inherent from Logan for the following reasons.

1. Logan in paragraph 41 describes segments having metadata for identification, e.g. short text labels. These short text labels identify the different segments in the segment index or guide (see para. 42 and Figs. 2 and 3). The user can select the different segments by scrolling the segments. Logan is silent on how the segments are actually selected. However, as the segments are displayed by their "label" and chosen by the user by their "label" it would be logical that the system selects the desired segment by the metadata short text label and not based on time.

2. In Logan, since at any time during the play of the content, a user can choose from many different segments, which are generally related to different playtimes of the content, from the segment index (para. 42), it would not make sense to say that the selection is identified based on the time at which the selection was selected, **as the time of selection in Logan is irrelevant**. Therefore, Logan teaches away from identifying a selection by the time of selection.

3. Since it is most likely that selection of the desired segment is via the metadata short text label and Logan teaches away from identifying the selection via the time of selection, the rejection based on "Inherency" cited in the Final Official Action is improper. Attention is directed to MPEP 2112 "Requirements of Rejection Based on Inherency; Burden of Proof":

> *"....To establish inherency,* ***the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference,*** *and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient..."*

The above arguments are also relevant to independent claims 75 and 156.

In view of the above remarks it is respectfully submitted that claims 75-78, 82-86, 95, 98-100, 103-106, 116, 127-130, 150, and 156 are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Favorable consideration and allowance of the present application are hereby respectfully requested.

Respectfully submitted,

CLIFFORD J. MASS
LADAS & PARRY LLP
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG.NO. 30086 (212) 708-1980